

EXHIBIT 12

PW 7021328

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

August 03, 2006

THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE
RECORDS OF THIS OFFICE OF THE FILE WRAPPER AND CONTENTS
OF:

APPLICATION NUMBER: 08/691,604

FILING DATE: August 15, 1996

PATENT NUMBER: 5,760,090

ISSUE DATE: June 02, 1998

By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office



T. Wallace
T. WALLACE
Certifying Officer

DLEV011712

54 649		Class: 514		ISSUE CLASSIFICATION: 514		SCANNED 3		5760090	
UTILITY SERIAL NUMBER: 681604		FILING DATE: 03/18/96		CLASS: 514		SUBCLASS: 649		GROUP ART UNIT: 1205	
INVENTOR: TIMOTHY L. BARBERICH, CONCORD, MA; JAMES W. YOUNG, STILL RIVER, MA.		EXAMINER: Henley		9200 Henley					
<p>***CONTINUING DATA*****</p> <p>VERIFIED THIS APPLN IS A CON OF US 335,450 11/07/94 PAT 5,547,995</p> <p>WHICH IS A CON OF 09/163,581 12/07/93 PAT 5,362,755</p> <p>WHICH IS A CON OF 07/895,725 06/09/92 AMO</p> <p>WHICH IS A CON OF 07/461,262 01/05/90 AMO</p>									
<p>***PREVIOUS/PC APPLICATIONS*****</p> <p>VERIFIED</p> <p>NOTE-DISCLAIMER</p> <p>The term of this patent shall not extend beyond the expiration date of Pat. No. 5,362,755</p>									
<p>***** SMALL ENTITY *****</p>									
Foreign priority claimed		<input type="checkbox"/> yes <input checked="" type="checkbox"/> no		AS FILED		STATE OR COUNTRY		SHEETS OR DRWS.	
35 USC 118 conditions met		<input type="checkbox"/> yes <input checked="" type="checkbox"/> no				TOTAL CLAIMS		INDEX CLAIMS	
Verified and Acknowledged		Examiner's Initials				FILING FEE RECEIVED		ATTORNEYS DOCKET NO.	
		Henley				\$375.00		9201602	
<p>PHILIP S. WINTER</p> <p>HELEN L. AND ROYCE H.</p> <p>1111 1111 1111</p> <p>1111 1111 1111</p>									
<p>U.S. DEPT. OF COMMERCE PAT. & TRADE MARK ADMIN.</p>									
<p>DATE OF APPLICATION FILED SEPARATELY</p>									
<p>NOTICE OF ALLOWANCE/REMAINDER</p>									
<p>7/21/97</p>									
<p>ISSUE FEE AD-</p>									
<p>Amount Due: 660.00 Date Paid: 3/19/98</p>									
<p>RAYMOND HENLEY</p> <p>PRIMARY EXAMINER</p> <p>PREPARED FOR ISSUE</p>									
<p>WARNING: The information disclosed herein may be used by the United States Code Title 35, Sections 122, 122A, Patent & Trademark Office is prohibited to authorize</p>									

DLEV011713

PATENT APPLICATION SERIAL NO. 08691604

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

240 DD 08/19/96 08691604
1 201 375.00 CK

PTO-1556
(5/87)

DLEV011715

Copy

REQUEST FOR FILING A PATENT APPLICATION UNDER 37 CFR 1.60
(Small Entity)

PATENT NUMBER	ANTICIPATED CLASSIFICATION	PRIOR APPLICATION	ART UNIT
07/1.027D	CLASS SUBCLASS	Henley, R.	1205

Address to:
Assistant Commissioner for Patents
Washington, D.C. 20231

This is a request for filing a ☒ continuation ☐ divisional application under 37 CFR 1.60 of pending prior application.
Serial Number 08/335,480 filed on 11/7/94 and entitled:
METHOD FOR TREATING ASTHMA USING OPTICALLY PURE R(-) ALBUTEROL

1. Enclosed is a copy of the latest inventor-signed prior application, including a copy of the oath or declaration showing the original signature or an indication it was signed. I hereby verify that the attached papers are a true copy of the latest signed prior application, Serial Number 07/461,262 and further that all statements made herein of my own knowledge are true and further that these statements were made with the knowledge that willful false statements and the like are made punishable by fine or imprisonment or both, under section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issuing thereon.

CLAIMS AS FILED

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	8	- 20 =	0	x \$11.00	\$0.00
Indep. Claims	2	- 3 =	0	x \$39.00	\$0.00
Multiple Dependent Claims (check if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					\$375.00
TOTAL FILING FEE					\$375.00

2. ☒ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27
☐ is enclosed.
☒ was filed in prior application Serial Number 07/461,262 and such status is still proper and desired (37 CFR 1.28(a)).

3. ☐ The Commissioner is hereby authorized to charge any fees which may be required under 37 CFR 1.16 and 1.17, or credit any overpayment to Deposit Account No. _____ A duplicate copy of this sheet is enclosed.

4. ☐ A check in the amount of _____ is enclosed.

5. ☐ Cancel in this application original claims _____ of the prior application before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)

6. ☐ Amend the specification by inserting before the first line the sentence: "This application is a ☐ continuation ☐ division of application Serial Number _____ filed _____ which application is now:
☐ abandoned,
☐ pending,
☐ other (explain): _____

7. ☐ Transfer the drawings from the pending prior application to this application and abandon said prior application as of the filing date accorded this application. A duplicate copy of this sheet is enclosed for filing in the prior application. (May only be used if signed by person authorized by 37 CFR 1.138 and before payment of issue fee.)

REQUEST FOR FILING A PATENT APPLICATION UNDER 37 CFR 1.60 (Small Entity)

☐ New formal drawings are enclosed.

☐ Priority of foreign application number _____ filed on _____ in _____
Country is claimed under 35 U.S.C. 119.

☐ The certified copy has been filed in prior application Serial Number _____ filed on _____

☐ A preliminary amendment is enclosed.

☒ The prior application is assigned of record to:

Sepracor, Inc.
111 Locke Drive
Marlborough, MA 01752

☒ Also enclosed:

Information Disclosure Citation and 2 references
Certificate of Mailing by Express Mail

☒ The power of attorney in the prior application is to:

Philip E. Hansen
Heslin & Rothenberg, P.C.
5 Columbia Circle
Albany, New York 12205

a. ☐ The power of attorney appears in the original papers in the prior application.

b. ☒ Since the power of attorney does not appear in the original papers, a copy of the power of attorney in the prior application is enclosed.

c. ☒ Address all future correspondence to: (May only be completed by applicant, or attorney or agent of record.)

Philip E. Hansen
Heslin & Rothenberg, P.C.
5 Columbia Circle
Albany, New York 12205

Dated: August 20 1996


Signature

Philip E. Hansen

Typed or printed name

37-700

Registration Number (if applicable)

☐ Inventor(s)

☐ Assignee of complete interest

☒ Attorney or agent of record

☐ Filed under 37 C.F.R. 1.34(a)

cc:

[Page 2 of 2]

DLEV011717

REQUEST FOR FILING A PATENT APPLICATION UNDER 37 CFR 1.62 (Small Entity)

DOCKET NUMBER	ANTICIPATED CLASSIFICATION		PRIOR APPLICATION EXAMINER	ART UNIT
0701.027D	CLASS	SUBCLASS	Healey, R.	1205

Address to:
Assistant Commissioner for Patents
Washington, D.C. 20231

This is a request for filing a ☐ continuation-in-part ☒ continuation ☐ divisional application under 37 CFR 1.62 of prior application Number 08/335,480, filed on 11/7/94, entitled METHOD FOR TREATING ASTHMA USING OPTICALLY PURE R(-) ALBUTEROL.

RECEIVED

AUG 15 1996

OFFICE OF PETITIONS
ATTORNEYS

The following named inventor(s):

(a) Name of Sole or First Inventor

Timothy L. Barberich

Residence

73 Nashoba Road, Concord, MA 01742

Citizenship

U.S.A.

Post Office Address

73 Nashoba Road, Concord, MA 01742

☒ Additional inventors are being named on a separate sheet attached hereto.

The above identified prior application in which payment of the issue fee, ~~which was made~~ has occurred, is hereby expressly abandoned under 37 CFR 1.62(g) as of the filing date of this new application. Please use all the contents of the prior application file wrapper, including the drawing, as the basic papers for the new application. (No new specification is required.) (Note: 37 CFR 1.60 may be used for applications where the prior application is not to be abandoned.)

1. ☐ Enter the unentered amendment previously filed on _____ under 37 CFR 1.116 in the prior application.

2. ☐ A preliminary amendment is enclosed.

The filing fee is calculated on the basis of the claims existing in the prior application as amended at 1 and 2 above.

CLAIMS AS FILED

For	#Filed	#Allowed	#Extra	Rate	Fee
Total Claims	8	- 20 =	0	x \$11.00	\$0.00
Indep. Claims	2	- 3 =	0	x \$39.00	\$0.00
Multiple Dependent Claims (if applicable) <input type="checkbox"/>					\$0.00
BASIC FEE					\$375.00
TOTAL FILING FEE					\$375.00

Copyright 1995, Legabiol

[Page 1 of 3]

P22SMALLREV01

DLEV011718

REQUEST FOR FILING A PATENT APPLICATION UNDER 37 CFR 1.62

3. ☒ A verified statement to establish small entity status under 37 CFR 1.9 and 1.27
☐ is enclosed
☒ was filed in the prior application and such status is still proper and desired (37 CFR 1.28(a)).
4. ☒ The Commissioner is hereby authorized to charge fees under 37 CFR 1.16 and 1.17 which may be required, or credit any overpayment to Deposit Account No. 08-1935. (A duplicate copy of this form is enclosed).
5. ☒ A check in the amount of \$375.00 is enclosed.
6. ☐ A new oath or declaration in compliance with 37 CFR 1.63 is included since this application is a continuation-in-part which discloses and claims additional matter.
7. ☒ Amend the specification by inserting before the first line the sentence:
This application is a ☐ continuation-in-part, ☒ continuation, ☐ division, of application number 08/335,480 filed 11/7/94, now abandoned.
8. ☐ Priority of foreign application number _____, filed on _____ in _____ Country.
9. ☒ The prior application is assigned of record to
Sepracor, Inc.
10. ☒ The power of attorney in the prior application is to: (name & address)
Philip E. Hansen
Heslin & Rothenberg, P.C.
5 Columbia Circle
Albany, New York 12203
11. ☒ Also enclosed:
Express Mail Certificate
Petition To Withdraw Application From Issue

Address all future correspondence to: (May only be completed by applicant, or attorney or agent of record)

Philip E. Hansen
Heslin & Rothenberg, P.C.
5 Columbia Circle
Albany, NY 12203

It is understood that secrecy under 35 U.S.C. 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 CFR 1.62 application, be it either this application or a prior application in the same file wrapper, the Patent and Trademark Office may provide similar information or access to all the other applications in the same file wrapper.

Dated: August 14 1996

Philip E. Hansen
Signature

Philip E. Hansen

Typed or printed name

- ☐ Inventor(s)
☐ Assignee of complete interest
☒ Attorney or agent of record
☐ Filed under 37 C.F.R. 1.34(a)

cc:

Full name of second inventor, if any	
James W. Young	
Residence	
765 Tallman Court, Palo Alto, CA 94303	
Citizenship	
U.S.A.	
Post Office Address	
765 Tallman Court	
Palo Alto, CA 94303	
Full name of third inventor, if any	
Residence	
Citizenship	
Post Office Address	
Full name of fourth inventor, if any	
Residence	
Citizenship	
Post Office Address	
Full name of fifth inventor, if any	
Residence	
Citizenship	
Post Office Address	

[Page 3 of 3]

DLEV011720

SPC89-05
1/4/90
PAC16PATENT APPLICATION
DOCKET NO: SPC89-05

08/69/604

METHOD FOR TREATING ASTHMA USINGOPTICALLY PURE R(-) ALBUTEROL

THIS IS A CONTINUATION OF U.S. Application 08/335,480, Filed November 7, 1994, Now U.S. Patent No. 5,547,994, which is a continuation of U.S. Application 08/110,358, Filed December 7, 1993, Now U.S. Patent No. 5,362,755, which is a continuation of U.S. Application 07/896,725, Filed June 9, 1992, Abandoned, which is a continuation of U.S. Application 07/146,262, Filed January 5, 1990, Abandoned.

DESCRIPTIONBackground

- 05 Albuterol is a drug belonging to the general class of beta-adrenergic compounds. The prime action of beta-adrenergic drugs is to stimulate adenylyl cyclase, the enzyme which catalyzes the formation of cyclic-3',5'-adenosine monophosphate (AMP) from adenosine triphosphate (ATP). The cyclic AMP formed mediates the cellular responses.
- 10 Albuterol acts selectively on beta₂-adrenergic receptors to relax smooth muscle tissue, for example, in the bronchial system. Albuterol is most commonly used to treat bronchial spasms associated with asthma and is the active component in well-known commercial bronchodilators such as Proventil and Ventolin.

- 20 The form in which albuterol is presently used is a racemic mixture. That is, it is a mixture of optical isomers, called enantiomers. Enantiomers are structurally identical compounds which differ only in that one isomer is a mirror image of the other and the mirror images cannot be superimposed.
- 25 This phenomenon is known as chirality. Most biological molecules exist as enantiomers and exhibit chirality. Although structurally identical, enantiomers can have profoundly different effects in biological systems: one enantiomer may have a

DLEV011721

-2-

specific biological activity while the other enantiomer has no biological activity at all, or may have an entirely different form of biological activity.

05 Summary of the Invention

The present invention relates to a method of treating bronchial disorders, such as asthma, in an individual, by administering to the individual an amount of optically pure R(-) albuterol which is active in bronchial tissue sufficient to reduce bronchial spasms associated with asthma while minimizing side effects associated with albuterol. The method is particularly useful in treating asthma while reducing side effects, such as central nervous system stimulatory effects and cardiac arrhythmia. In these applications, it is important to have a composition which is a potent broncho-dilator and which does not exhibit the adverse side effects of many beta-adrenergic drugs. A composition containing the pure R(-) isomer of albuterol is particularly useful for this application because this isomer exhibits these desired characteristics. The present method provides a safe, effective method for treating asthma while reducing undesirable side effects, for example, tremor, nervousness, shakiness, dizziness and increased appetite, and particularly, cardiac arrhythmia, typically associated with beta-adrenergic drugs. In children, side effects such as excitement, nervousness and hyperkinesia are reduced when the pure isomer is

DLEV011722

-3-

administered. In addition to the above, at certain levels racemic albuterol can cause teratogenic effects, which are believed to be associated with the S(+) isomer. Administering the pure isomer reduces the teratogenic potential which is associated with the S(+) isomer of albuterol.

Detailed Description of the Invention

The present invention relies on the broncho-dilation activity of the R(-) enantiomer of albuterol to provide relief from bronchial disorders, while simultaneously reducing undesirable side effects, for example, central nervous system stimulatory effects and cardiac disorders, commonly experienced by albuterol users. In the present method, the optically pure R(-) isomer of albuterol, which is substantially free of the S(+) enantiomer, is administered alone, or in combination with one or more other drug(s) in adjunctive treatment, to an individual in whom asthma relief (e.g., relief from bronchial spasms, shortness of breath) is desired. The optically pure R(-) isomer of albuterol as used herein refers to the leverotatory optically pure isomer of α^1 [(tert-butylamine) methyl]-4-hydroxy-m-xylene- α , α' -diol, and to any biologically acceptable salt or ester thereof. The terms "optically pure" or "substantially free of the S(+) enantiomer" as used herein means that the composition contains at least 90% by weight of the R(-) isomer of albuterol and 10% by weight or less of the S(+) isomer. Optically pure albuterol is readily

DLEV011723

-4-

obtainable by methods known to those of skill in the art, for example, by synthesis from an optically pure intermediate.

In the present method, the R(-) isomer of albuterol is administered to an individual who has asthma. For example, R(-) albuterol is administered to an individual after onset of asthma to reduce breathing difficulty resulting from asthma. In another embodiment, optically pure R(-) albuterol is administered prophylactically, that is, before the bronchospasm begins in an asthma attack, to prevent its occurrence or to reduce the extent to which it occurs.

In the present method, R(-) albuterol can be administered by inhalation, by subcutaneous or other injection, orally, intravenously, topically, parenterally, transdermally, rectally or via an implanted reservoir containing the drug. The form in which the drug will be administered (e.g., inhalant, powder, tablet, capsule, solution, emulsion) will depend on the route by which it is administered. The quantity of the drug to be administered will be determined on an individual basis, and will be based at least in part on consideration of the individual's size, the severity of the symptoms to be treated and the result sought. In general, quantities of optically pure R(-) albuterol sufficient to reduce the symptoms of asthma will be administered. The actual dosage (quantity administered at a time) and the number of administrations per day will depend on the mode of

DLEV011724

-5-

administration, for example, by inhaler, nebulizer or oral administration. About 30 mcg to about 90 mcg of the optically pure R(-) isomer of albuterol given by inhalation one or more times per day will be adequate in most individuals to produce the desired bronchodilation effect. For oral administration, e.g., tablet or syrup, a dose of about 1 mg to about 8 mg two to four times daily is administered to produce the desired effect.

In the method of the present invention, the optically pure R(-) isomer of albuterol can be administered together with one or more other drug(s). For example, an antiasthmatic drug such as theophylline or terbutaline, or an antihistamine or analgesic such as aspirin, acetaminophen or ibuprofen, can be given with or in close temporal proximity to administration of optically pure, R(-) albuterol. The two (or more) drugs (the optically pure active isomer of albuterol and another drug) can be administered in one composition or as two separate entities. For example, they can be administered in a single capsule, tablet, powder, or liquid, etc. or as individual compounds. The components included in a particular composition, in addition to optically pure albuterol and another drug or drugs, are determined primarily by the manner in which the composition is to be administered. For example, a composition to be administered in inhalent form can include, in addition to the drug(s), a liquid carrier and/or propellant. A composition to be administered in

ORIGINAL RECEIVED

6

DLEV011725

-6-

tablet form can include a filler (e.g., lactose), a binder (e.g., carboxymethyl cellulose, gum arabic, gelatin), an adjuvant, a flavoring agent, a coloring agent and a coating material (e.g., wax or a plasticizer). A composition to be administered in liquid form can include the combination of drugs and, optionally, an emulsifying agent, a flavoring agent and/or a coloring agent.

In general, according to the method of the present invention, the optically pure R(-) isomer of albuterol, alone or in combination with another drug(s), is administered to an individual periodically as necessary to reduce symptoms of asthma.

The present composition and method provide an effective treatment for asthma while minimizing the undesirable side effects associated with albuterol use. These side effects include central nervous system effects, such as tremor, nervousness, shakiness, dizziness and increased appetite, and cardiac effects, such as cardiac arrhythmia. In children, side effects, such as excitement, nervousness and hyperkinesia, are reduced when the pure isomer is administered. In addition, teratogenic effects associated with albuterol are believed to reside in the S(+) enantiomer. Thus, administering the pure R(-) isomer may reduce the teratogenic potential associated with albuterol.

Equivalents

Those skilled in the art will recognize, or be able to ascertain, using no more than routine

DLEV011726

-7-

experimentation, many equivalents to the specific embodiments of the invention described herein. Such equivalents are intended to be encompassed in the scope of the following claims.

RECEIVED
APR 16 2008
FBI - NEW YORK

8

DLEV011727

-8-

CLAIMS

1. A method of treating asthma in an individual with albuterol, while reducing side effects associated with albuterol, comprising administering to the individual a quantity of an optically pure R(-) isomer of albuterol sufficient to result in bronchodilation, said R isomer being substantially free of its S(+) isomer.
05
2. A method of Claim 1 wherein the amount of the R(-) isomer of albuterol is greater than approximately 90% by weight.
10
3. A method of Claim 1 wherein the amount of the R(-) isomer of albuterol is greater than 99% by weight.
15
4. A method of Claim 1 comprising administering to the individual by inhalation from approximately 30 mcg to approximately 90 mcg of the R(-) isomer of albuterol per dose.
20
5. A method of Claim 1 comprising orally administering to the individual from approximately 1 mg to approximately 8 mg of the R(-) isomer of albuterol two to four times daily.
25

DLEV011728

-9-

6. A method of treating asthma in an individual with albuterol, while reducing side effects associated with albuterol, comprising administering to the individual a quantity of an optically pure R(-) isomer of albuterol sufficient to result in bronchodilation and at least one additional drug.
7. A method of Claim 6 wherein the additional drug is selected from the group consisting of: bronchodilators, antihistamines and analgesics.
8. A method of Claim 7 wherein the analgesic is selected from the group consisting of: aspirin, acetaminophen and ibuprofen.
9. A composition comprising an optically pure R(-) isomer of albuterol and at least one additional drug.
10. A composition of Claim 9 containing at least 90% by weight of the R(-) isomer of albuterol.
11. A composition of Claim 10 containing at least 99% by weight of the R(-) isomer of albuterol.
12. A composition of Claim 9 wherein the additional drug is selected from the group consisting of: bronchodilators, antihistamines and analgesics.

DLEV011729

08/09/04

-10-

METHOD FOR TREATING ASTHMA USING
OPTICALLY PURE R(-) ALBUTEROL

Abstract of the Disclosure

05 The optically pure R(-) isomer of albuterol,
which is substantially free of the S(+) isomer, is a
potent bronchodilator for relieving the symptoms
associated with asthma in individuals. A method is
disclosed utilizing the optically pure R(-) isomer
of albuterol for treating asthma while minimizing
10 the side effects associated with albuterol.

RECEIVED 08/09/04

DLEV011730

NOV 07 '94 02:37PM SEPTEMBER INC. PHILADELPHIA
89-05

P. 2/4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Declaration for Patent Application

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name:

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

METHOD FOR TREATING ASTHMA USING OPTICALLY PURE R(-)ALBUTEROL

the specification of which (check one)

☐ is attached hereto.

☒ was filed on January 5, 1990 as
Application Serial No. 07/461,262 (if applicable).
and was amended on _____

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

			Priority Claimed	
(Number)	(Country)	(Day/Month/Year filed)	Yes	No
_____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>
_____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>
_____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>

DLEV011731

NOV 07 '94 02:38PM SEPRACOR INC MARLBORO

P.3/4

-2-

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

(Application Serial No.)	(Filing date)	(Status, patented, pending, abandoned)
(Application Serial No.)	(Filing date)	(Status, patented, pending, abandoned)

(Application Serial No.)	(Filing date)	(Status, patented, pending, abandoned)
(Application Serial No.)	(Filing date)	(Status, patented, pending, abandoned)

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

I also hereby grant additional Powers of Attorney to the following attorney(s) and/or agent(s) to file and prosecute an international application under the Patent Cooperation Treaty based upon the above-identified application, including a power to meet all designated office requirements for designated states.

David E. Brook	Registration No. 22,592
James M. Smith	Registration No. 28,043
Leo R. Reynolds	Registration No. 20,884
Giulio A. DeConti, Jr.	Registration No. 31,503
Richard A. Wise	Registration No. 18,041
Patricia Granahan	Registration No. 32,227
Mary Lou Wakimura	Registration No. 31,804
Thomas O. Hoover	Registration No. 32,470
Paula A. Campbell	Registration No. 32,503
Alice C. Olek	Registration No. 33,542

all of Hamilton, Brook, Smith and Reynolds, P.C., Two Militia Drive, Lexington, Massachusetts 02173;

and

Send correspondence to: Patricia Granahan, Esq.
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
Two Militia Drive, Lexington, Massachusetts 02173

Direct telephone calls to: Patricia Granahan, Esq.

617-861-6240

DLEV011732

MAY 01 '94 02:30PM SEPTEMBER 1994 PROCEEDINGS

-3-

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor Timothy J. Barberich
 Inventor's Signature Timothy J. Barberich Date 2/28/90
 Residence 73 Nashoba Road MA
Concord, Massachusetts 01742
 Citizenship USA
 Post Office Address SAME

Full name of second joint inventor, if any James W. Young
 Second Inventor's Signature James W. Young Date 1 March 90
 Residence 295 Still River Road MA
Still River, Massachusetts 01467
 Citizenship USA
 Post Office Address SAME

Full name of third joint inventor, if any
 Third Inventor's Signature _____ Date _____
 Residence _____
 Citizenship _____
 Post Office Address _____

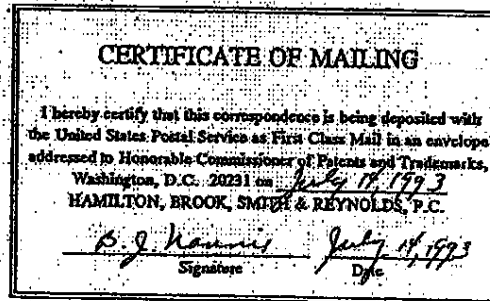
Full name of fourth joint inventor, if any
 Fourth Inventor's Signature _____ Date _____
 Residence _____
 Citizenship _____
 Post Office Address _____

DLEV011733



PATENT APPLICATION
Pocket No. SPC89-05'

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Applicant: Timothy J. Barberich and James W. Young
Serial No.: 07/896,725 Group Art Unit: 1205
Filed: June 9, 1992 Examiner: L. Schenkman
For: METHOD FOR TREATING ASTHMA USING OPTICALLY PURE
R(-) ALBUTEROL



ASSOCIATE POWER OF ATTORNEY

The Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

The undersigned, as attorney of record, hereby grants to Philip E. Hansen, Registration No. 32,700, of the firm of Heslin & Rothenberg, 450 New Karner Road, P.O. Box 12695, Albany, New York 12212-2695, an Associate Power of Attorney in the above-captioned application.

Please continue to send all correspondence to the attention of the undersigned attorney at Hamilton, Brook, Smith & Reynolds, P.C., Two Militia Drive, Lexington, MA 02173.

Respectfully submitted,

Patricia Granahan

Patricia Granahan
Registration No. 32,227
Attorney for Applicant(s)
(617) 861-6240

Lexington, Massachusetts

Dated: July 13, 1993

DLEV011734



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
08/691,604	08/15/96	BARBERICH	T 0701, 027D

PHILIP E HANSEN
HESLIN AND ROTHENBERG
5 COLUMBIA CIRCLE
ALBANY, NY 12203

0242/0905

0000

09/05/96

**NOTICE OF IMPROPER FIVE FILING UNDER 37 CFR 1.62
NO FILING DATE GRANTED**

The above identified application was deposited under 37 CFR 1.62 as a file wrapper continuing application but is improper and has not been granted a filing date for reasons shown below:

1. The application does not include the correct application number including filing date or series code of the prior application.
2. The application, which is not a continuation-in-part, was not filed by the same or less than all the inventors named in the prior application and no petition for correction of inventorship was filed.
3. The application, which is a continuation-in-part, does not identify the names of all the inventors (37 CFR 1.41(a)). The application uses "et al" but only one inventor was named in the prior application.
4. The filing date included a new specification or a copy of a specification from the prior application. See 37 CFR 1.62(e). A petition with the \$ _____ fee set forth in 37 CFR 1.17(d)(1) with instructions to cancel the copy or specification may be filed if a filing date as of the receipt date noted above is desired.
5. The request does not include an original signature of the inventor(s), assignee of the entire interest, or registered attorney or agent.
6. The application was not filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application:
 - a) The issue fee was paid on the prior application on _____.
 - b) The prior application was abandoned, or proceedings terminated on _____.
 - c) The prior application was abandoned by the filing of application number _____ on _____ under 37 CFR 1.62.

7. Other: *Petition was Dismissed to Grant Continuity*

The filing date will be the date of receipt of the items required above unless otherwise indicated, provided the items are filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application. Any assertions that the items required above were submitted or are not necessary for a filing date must be by a petition directed to the attention of the Office of the Assistant Commissioner for Patents. Any such petition must be accompanied by the \$ _____ fee (37 CFR 1.17(b)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

All of the above noted items and/or any petition must be submitted within TWO MONTHS of the date of this notice (37 CFR 1.81(f)) or the application will be returned upon request or abandoned and the fee, if submitted, will be refunded less the \$ _____ handling fee (37 CFR 1.21(b)). THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136.

Direct the response and any questions about this notice to, Attention: Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

Application Processing Division
(703) 308-1202
FORM PTOA-457 (REV. 12-85)

PART 1

DLEV011735



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Barberich et al.

Serial No.: 08/691,604

Filed: (No filing date granted) (Received August 15, 1996)

Title: METHOD FOR TREATING ASTHMA USING OPTICALLY PURE
R(-) ALBUTEROL

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on November 5, 1996.


Philip E. Hansen
Agent for Applicant
Registration No. 32,700

Date of Signature: November 5, 1996

Assistant Commissioner for Patents
Washington, D.C. 20231

Attention: Application Processing Division
Special Processing and Correspondence Branch

RESPONSE TO NOTICE OF IMPROPER FWC FILING
UNDER 37 CFR 1.62 NO FILING DATE GRANTED

Sir:

This is submitted in response to a Notice of Improper FWC Filing under 37 CFR 1.62 issued on September 5, 1996 in connection with the above-identified application. The deadline for responding to the Notice is November 5, 1996. Accordingly, this Response to Notice of Improper FWC Filing is timely filed.

Enclosed herewith are:

- (a) a copy of the Notice of Improper FWC Filing Under 37 CFR 1.62 No Filing Date Granted;

F:\USERS\HFF\0701037D.MIS
November 5, 1996

DLEV011736

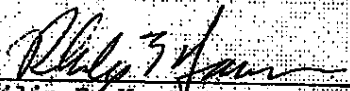
Barberich et al.
Serial No.: 08/691,604
Page -2-

- (b) a copy of a Petition to Convert a Continuing Application Filed Under 37 CFR §1.62 to a Continuing Application Under 37 CFR §1.60;
- (c) a copy of the postcard accompanying the above Petition, showing that the Petition and the necessary accompanying documents were received by the USPTO on August 23, 1996.

As noted in the "Notice of Improper FWC Filing Under 37 CFR 1.62 No Filing Date Granted", a petition to withdraw the parent from issue was dismissed, rendering the present FWC improper. A petition to convert has been filed. Applicant is awaiting a decision on that petition. Applicant presumes that when the petition is granted the present application serial number 08/691,604 will be converted to a regular continuing application having a filing date of August 15, 1996.

Any communication regarding this matter should be directed to the undersigned.

Respectfully submitted,


Philip E. Hansen
Agent for Applicant
Registration No. 32,700

Dated: November 5, 1996

HESLIN & ROTHENBERG, P.C.
5 Columbia Circle
Albany, New York 12203
Telephone: (518) 452-5600
Facsimile: (518) 452-5579

F:\DSSRS\HFF\0701027D.MIS
November 5, 1996

DLEV011737

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
BARBERICH, Timothy et al.

Art Unit: 1205

Serial No. 08/335,480
Filed: November 7, 1994

Examiner: Henley, R.


Group 1205

For: METHOD FOR TREATING ASTHMA USING
OPTICALLY PURE R(-) ALBUTEROL

X3

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Office of Petitions, Box DAC, Washington, D.C. 20231, August 20, 1996.


Philip E. Hansen
Agent for Applicant
Reg. No. 32,700

Date of Signature: August 20, 1996

Assistant Commissioner for Patents
Office of Petitions
Box DAC
Washington, D.C. 20231

Attention: Karen Babington

PETITION TO CONVERT A CONTINUING APPLICATION FILED UNDER
37 C.F.R. 1.62 TO A CONTINUING APPLICATION FILED UNDER
37 C.F.R. 1.60

Dear Sir:

Applicant hereby petitions the Commissioner to convert to a Continuation under 37 CFR §1.60 the File Wrapper Continuing application filed with the petition to withdraw the above-identified application from issue. The Petition to Withdraw from

F:\USERS\KFF\0701027C.FE2
August 20, 1996

DLEV011738

Barberich et al.
Page -2-

Issue was hand carried to the Office of Petitions on August 15, 1996, and was denied on August 20, 1996. Applicant's undersigned representative was informed by Examiner Karen Babington that the proper way to have art brought before the patent office, in light of the denial of the petition, was a petition to convert the PWC to a Rule 60 continuation.

A check in the amount of \$130 to cover the fee required by \$1.182 as set forth in \$1.17(h) is appended hereto. Without wishing to seem accusatory or disrespectful, applicants' representative notes that considerable time and expense could have been saved for both applicants and the Patent Office had he been informed (either by published policy or by any of the several persons in the Office of Petitions and in the Publication Division with whom he spoke before filing the petition to withdraw) that petitions to withdraw are, as a matter of policy, denied if they arrive less than seven days before issue. Applicants' representative does not question the reasonableness of the policy, but only its lack of promulgation. With foreknowledge of this policy, a continuing application under Rule 1.60 could have been filed in the first instance.

Enclosed herewith are: (1) a true copy of the prior complete application, including the latest inventor-signed oath; (2) a transmittal letter for the proposed Rule 60 application; and (3) a form 1449 and copies of two additional references, not previously of record in the case. Applicants respectfully

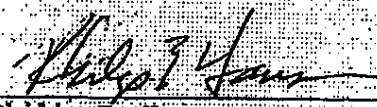
F:\USERS\BPP\0701027C.FE2
August 20, 1996

DLEV011739

Barberich et al.
Page -3-

petition that the request for a Continuation under 37 CFR §1.62 of the above-identified application be converted to an request for Continuation under 37 CFR §1.60.

Respectfully submitted,


Philip E. Hansen
Agent for Applicants
Reg. No. 32,700

Dated: August 20, 1996

Address for Correspondence:
Philip E. Hansen
Heslin & Rothenberg, P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579

P:\USERS\BPP\0701077C.PK2
August 20, 1996

DLEV011740



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
--------------------	--------------	-----------------------	------------------------

09/691,604 08/16/96 BARBERICH I 0701.027D

0242/0905

PHILIP E HANSEN
HESLIN AND ROTHENBERG
5 COLUMBIA CIRCLE
ALBANY NY 12203

0000

NOTICE OF IMPROPER FWC FILING UNDER 37 CFR 1.62 09/05/96
NO FILING DATE GRANTED

The above identified application was deposited under 37 CFR 1.62 as a file wrapper continuing application but is improper and has not been granted a filing date for reasons shown below:

1. The application does not include the correct application number including filing date or serial code of the prior application.
2. The application, which is not a continuation-in-part, was not filed by the same or less than all the inventors named in the prior application and no petition for correction of inventorship was filed.
3. The application, which is a continuation-in-part, does not identify the names of all the inventors (37 CFR 1.41(a)). The application uses "et al" but only one inventor was named in the prior application.
4. The filing date included a new specification or a copy of a specification from the prior application. See 37 CFR 1.62(e). A petition with the \$_____ fee set forth in 37 CFR 1.17(d)(1) with instructions to cancel the copy or specification may be filed if a filing date as of the receipt date noted above is desired.
5. The request does not include an original signature of the inventor(s), assignee of the entire interest, or registered attorney or agent.
- ☒ 6. The application was not filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application:
 - ☒ a) The issue fee was paid on the prior application on _____
 - ☐ b) The prior application was abandoned, or proceedings terminated on _____
 - ☐ c) The prior application was abandoned by the filing of application number _____ on _____, under 37 CFR 1.62.
- ☒ 7. Other: PENITION WAS DISMISSED NO GRANT CONTINUITY

The filing date will be the date of receipt of the items required above unless otherwise indicated, provided the items are filed before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application. Any assertions that the items required above were submitted or are not necessary for a filing date must be by a petition directed to the attention of the Office of the Assistant Commissioner for Patents. Any such petition must be accompanied by the \$_____ fee (37 CFR 1.17(h)). If the petition states that the application is complete, a request for refund of the petition fee may be included in the petition.

All of the above noted items and/or any petition must be submitted within TWO MONTHS of the date of this notice (37 CFR 1.81(f)) or the application will be returned upon request or abandoned and the fee, if submitted, will be refunded less the \$_____ handling fee (37 CFR 1.21(n)). THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136.

Direct the response and any questions about this notice to, Attention: Application Processing Division, Special Processing and Correspondence Branch.

A copy of this notice MUST be returned with the response.

Customer Care Division
Application Processing Division
(703) 308-1202

FOR FILING: SEE 37 CFR 1.17(d)(1) DATE: COPY TO BE RETURNED WITH RESPONSE

DLEV011741

ROOM 11
AUG 23 1996
TRADEMARK OFF.

9200 BO-122 1205
#24

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re Application of:
BARBERICH, Timothy et al.

Art Unit: 1205

Serial No. 08/335,480 08/691,604
Filed: November 7, 1994

Examiner: Henley, R.

Group 1205

For: METHOD FOR TREATING ASTHMA USING
OPTICALLY PURE R(-) ALBUTEROL

RECEIVED
NOV 6 1996

CERTIFICATE OF MAILING

OFFICE OF PETITIONS
WASHINGTON, D.C.

Whereby certify that this correspondence is
being deposited with the U.S. Postal Service
as first class mail in an envelope addressed
to: Assistant Commissioner for Patents,
Office of Petitions, Box DAC, Washington,
D.C. 20231, August 20, 1996.

Philip E. Hansen
Philip E. Hansen
Agent for Applicant
Reg. No. 32,700

\$130.00 REFUND SCHEDULED
PP

Date of Signature: August 20, 1996

Assistant Commissioner for Patents
Office of Petitions
Box DAC
Washington, D.C. 20231

MAR 31 1997

Attention: Karen Babington

By Treasury Clerk in approximately
ten (10) days from above date.
CHIEF ACCOUNTING OFFICER
PATENT TRADEMARK OFFICE

PETITION TO CONVERT A CONTINUING APPLICATION FILED UNDER
37 C.F.R. 1.62 TO A CONTINUING APPLICATION FILED UNDER
37 C.F.R. 1.60

Dear Sir:

Applicant hereby petitions the Commissioner to convert to a
Continuation under 37 CFR §1.60 the File Wrapper Continuing
application filed with the petition to withdraw the above-
identified application from issue. The 278810826/96083 withdraw from
1 12 130.00 CK

F:\USERS\RFP\0701027C.PE2
August 20, 1996

DLEV011742

Barberich et al.
Page -2-

Issue was hand carried to the Office of Petitions on August 15, 1996, and was denied on August 20, 1996. Applicant's undersigned representative was informed by Examiner Karen Babington that the proper way to have art brought before the patent office, in light of the denial of the petition, was a petition to convert the PWC to a Rule 60 continuation.

A check in the amount of \$130 to cover the fee required by \$1.182 as set forth in \$1.17(h) is appended hereto. Without wishing to seem accusatory or disrespectful, applicants' representative notes that considerable time and expense could have been saved for both applicants and the Patent Office had he been informed (either by published policy or by any of the several persons in the Office of Petitions and in the Publication Division with whom he spoke before filing the petition to withdraw) that petitions to withdraw are, as a matter of policy, denied if they arrive less than seven days before issue. Applicants' representative does not question the reasonableness of the policy, but only its lack of promulgation. With foreknowledge of this policy, a continuing application under Rule 1.60 could have been filed in the first instance.

Enclosed herewith are: (1) a true copy of the prior complete application, including the latest inventor-signed oath; (2) a transmittal letter for the proposed Rule 60 application; and (3) a form 1449 and copies of two additional references, not previously of record in the case. Applicants respectfully

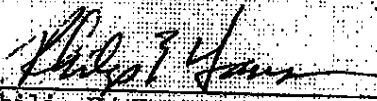
F:\USERS\RFP\0701027C.PS2
August 20, 1996

DLEV011743

Barberich et al.
Page -3-

petition that the request for a Continuation under 37 CFR §1.62 of the above-identified application be converted to an request for Continuation under 37 CFR §1.60.

Respectfully submitted,



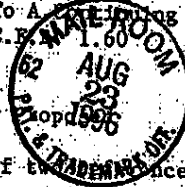
Philip E. Hansen
Agent for Applicants
Reg. No. 32,700

Dated: August 20, 1996

Address for Correspondence:
Philip E. Hansen
Heslin & Rothenberg, P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579

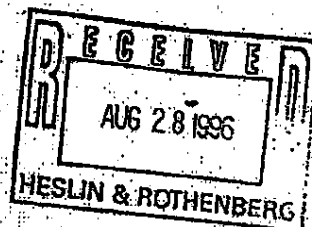
Applicant: Barberich et al.
Title: METHOD FOR TREATING ASTHMA USING OPTICALLY
PURE R(-) ALBUTEROL

Enclosed: Petition to Convert A Continuing Application
- Filed Under 37 C.F.R. 1.62 To A
Application Filed Under 37 C.F.R. 1.60
Check for \$130
Copy of Application
Copy of Transmittal Letter for
Rule 60 application
Copy of Form 1449 and copies of two
Copy of Declaration
Copy of Associate Power of Attorney



0701.027B/FEH/rfp

August 20, 1996



DLEV011745



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 5

Philip E. Hansen
Heslin and Rothenberg
5 Columbia Circle
Albany, NY 12203

COPY MAILED

FEB 28 1997

**OFFICE OF PETITIONS
A/C PATENTS**

In re application of
Timothy J. Barberich, et al
Application No. 08/691,604
Filed: August 15, 1996
Attorney Docket No. 0701.027D

**DECISION GRANTING
PETITION**

This is a decision in response to the communication filed November 7, 1996, requesting, in effect, consideration of a petition filed August 23, 1996, requesting that the above-identified application be treated as a continuation application under 37 CFR 1.60 rather than under 37 CFR 1.62. The communication is filed in response to a Notice of Improper FWC Filing mailed September 5, 1996, and provides a copy of a petition filed August 23, 1996, and the postcard receipt therefor.

The application was deposited on August 15, 1996, requesting a continuation application under 37 CFR 1.62 of prior application No. 08/335,480. However, the issue fee was paid in the prior application, and the application issued as U.S. Patent No. 5,547,994 on August 20, 1996.

Petitioners indicate that a petition under 37 CFR 1.313(b)(5) was filed in the prior application simultaneously with the continuing application. However, petitioners note that the request to withdraw the prior application from issue was denied on August 20, 1996. Accordingly, petitioners request that the application be considered under 37 CFR 1.60. No papers in compliance with 37 CFR 1.60 were included with the copy of the petition filed November 7, 1996.

A review of the record of the prior application confirms that the petition under 37 CFR 1.313(b)(5) filed on August 15, 1996, was dismissed in a decision mailed August 20, 1996, since the petition did not reach the deciding official in sufficient time to avert the issuance of the patent. It is also noted that

DLEV011746